

**PATENT AMENDMENT TRANSMITTAL FORM**

Docket No.: **K&B-25**

In re Patent Application of  
Paul M. Block & Steven Kunreuther

Serial No.: 10/073,089

Filed: February 12, 2002

For: IMPROVED AUTOMATIC  
ATTACHING APPARATUS

Examiner: Sameh Tawfik

Art Unit: 3721

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Dear Sir:

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- ☒ (x) Amendment
- ☒ (x) Specification - Clean Version
- ☒ (x) Specification - Underlined Version

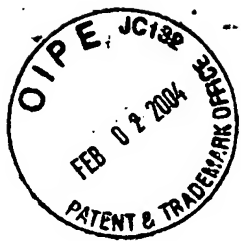
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January 30, 2004.

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**AMENDMENT**

This is in response to the Office Action dated November 7, 2003, in which applicants have been instructed to insert headings into the specification and Claims 1-9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Meyers in view of Block.

Regarding the headings, applicants present two versions of a substitute specification into which the headings have been inserted. One version contains underlines indicating the inserts. The other version is a clean version. No new matter, other than the headings, has been inserted into the specification, which is otherwise the same as the original.

With respect to the rejection under 35 U.S.C. 103(a), this rejection is believed to be inappropriate because neither reference teaches applicants' invention and thus the proposed

combination, if possible, would not result in an apparatus with applicants' claimed features. Further, the teachings of Meyers and Block are fundamentally incompatible and cannot be combined as proposed. In any case, the cited references lack any teaching, suggestion or motivation to make the proposed combination.

Claims 1-9, directed to an automatic apparatus for attaching tags, all require:

- (a) tag support means;
- (b) means for clamping a tag on the tag support means; and
- (c) means for moving the fastener dispensing means relative to the tag support means.

The Examiner states that Meyers teaches tag support means. This is incorrect. As clearly shown in Figure 7, Meyers' vacuum transport arm places the tag 66 over needle 30 of attacher 20. The tag rests on the needle until the article is placed over the needle and the attacher is actuated. There is no tag support means, nor is any tag support means required, when, as in this patent, a stationary attacher with an upwardly directed needle, upon which the tag is situated, is employed.

The Examiner also states that Meyers has means for moving the fastener dispensing means relative to the tag support means to cause the needle to pass through the tag and the article. This is also incorrect. Meyers employs an attacher 20 that is fixed to the table 16 by bracket 22, as seen in Figure 2.

The Examiner states that Meyers lacks means for clamping the tag on the tag support. That is correct. In Meyers, the article, placed over the needle by the operator, acts to retain the tag on the needle as the fastener is ejected.

Block is cited to make up for the lack of clamping means. In that regard, Block's anvil 22 is noted. Here again the Examiner is incorrect. Block's anvil 22, as clearly illustrated in Figures 8-13, is used to clamp article 15, not tag 12. *also clamping tag 12*

In fact, in Block, tags are removed, one at a time, from the bottom of the stack by feeder element 45 and moved into alignment with needle 54 of attacher 56. The tag is held in that position by feeder element 45 until the attacher is moved downward, needle 54 penetrates the tag and the clamped article 15, and the fastener is ejected through the needle, attaching the tag to the article.

Accordingly, neither Meyers nor Block teach the use of tag support means. Neither teaches the use of any means for clamping the tag on the tag support means. Therefore, if the proposed combination could be made, the resulting apparatus would not include either of those elements, and could not meet the limitations of applicants' claims.

These references could not be combined because they are fundamentally incompatible. Meyers has a fixed, upwardly directed attacher. The tag is fed from above, down on the attacher needle. Block has a moveable, downwardly directed attacher. The tag is fed from the side to a location under the attacher. In Meyers, the operator places the article over the fixed needle after the tag is placed on the needle. In Block, the operator places the article on anvil 22. Anvil 22 is moved upward to clamp the article between the anvil and the undersurface of the tag feeder. The attacher is then moved downward, through the aligned tag and the clamped article. Thus, considerable modifications to major portions of one or both references would be required to make the proposed combination. There is no teaching in either reference as the desirability for making such modifications.

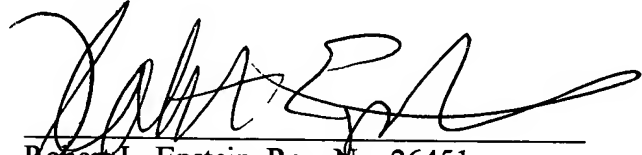
Moreover, the combination of these references is inappropriate because there is no teaching, motivation or suggestion in either reference to select particular elements from each and combine the references as the Examiner proposes. See In re Lee, 61 USPQ 2d 1430, 1433 (Fed. Cir. 2002) wherein the Court stated:

“The factual inquiry whether to combine references must be thorough and searching.” *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120m 1125-25m 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an ‘essential component of an obviousness holding’”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against the subtle but powerful attraction of a highlight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references”); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined only if there is some suggestion or incentive to do so”) (emphasis in original) (quoting *ACS Hosp. Sys. Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453m 1459 (Fed. Cir. 1998) (“even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.”); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”).

Accordingly, it is clear that the rejection based upon the proposed combination of Meyers and Block is in appropriate because there is no teaching, suggestion or motivation to make the combination. Reconsideration of the rejection and withdrawal thereof is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Robert L. Epstein', written over a horizontal line.

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